No. 20275

IN THE UNITED STATES COURT OF APPEALS

FOR THE NINTH CIRCUIT

COUNTY OF VENTURA
APPELLANT,

v.

O. V. BLACKBURN
APPELLEE

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF CALIFORNIA, CENTRAL DIVISION

REPLY BRIEF FOR APPELLANT

WOODRUFF J. DEEM
District Attorney

HERBERT L. ASHBY
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STATEMENT OF THE CASE

In the appellee's brief Blackburn contends that the statement of the case contained in the County's brief differs from the "Findings of Fact" and from the "evidence" (Blackburn Br. 1). The appellant's statement of the case need not be a verbatim restatement of the findings of fact drafted by the prevailing party below. It is respectfully submitted that the County's brief does fairly state the facts and the development of the case.

In an effort to show an alleged misstatement of facts in the County's brief, Blackburn cites as "evidence" his answers to pretrial interrogatories (Blackburn Br. 1, 3, 4, 5-6). The answers to the interrogatories, however, were not

admitted in evidence at the trial. Blackburn's answers would not be admissible in evidence on his own behalf but would be rejected as self-serving hearsay. See Haskell Plumbing & Heating Co. v. Weeks, 237 F.2d 263, 267 (9th Cir. 1956). When Blackburn's attorney offered to stipulate the interrogatories and answers into evidence, the judge stated that he did not think they were material (R.Tr. 102) and the County did not stipulate that they could be admitted in evidence. Thus the answers to interrogatories are not "evidence" in this case.

An examination of the County's brief and the record reveals that the "misstatements of facts" which Blackburn points out are really only differing opinions and conclusions. The one real misstatement he points to (Blackburn Br. 2) is actually an error in favor of Blackburn rather than the County. Renie testified to the value of the copyright on the map prior to the agreement (R.Tr. 79), whereas we stated that he testified to the value of the map (County Br. 4, lines 7-10). If the map was worth a certain amount, the exclusive right to copy, print, publish and sell it would surely be worth as much or more.

Blackburn's brief contains several erroneous statements and citations to the record. For example he contends that all persons involved in negotiating the agreement saw the copyright notices on the negatives (Blackburn Br. 2). But there is no evidence that anyone other than Blackburn actually

saw them. The only copyright notices on the eight negatives are contained in what Blackburn calls his "big titles" (R. Tr. 26, 35). These titles are approximately 2 inches high and 13½ inches long (See P. Exs. 2-A through 2-E). The word "copyright" is less than 1/8 of an inch high and 7/8 of an inch long. The eight negatives are all approximately 33 inches wide and vary in length from approximately 6 feet to 13 feet. The titles are not located on the map itself but are located in the blank areas at the bottom or top of the negatives. Thus it certainly cannot be said that everyone who looked at these large negatives necessarily saw the 1/8 inch by 7/8 inch word "copyright." If the "big titles" were visible at all when the negatives were provided to the County, the fact that they were placed at random on the negatives (for example, P. Ex. 2-A has five of these "titles" printed sideways in the lower left corner of the negative) may have led an observer interested in the map to believe that they were surplusage placed there for Blackburn's own use (see R.Tr. 19) and therefore to fail to see the small word "copyright."

Blackburn did not demonstrate that any of the eight negatives contained copyright notices when they were provided to the County, as his brief contends (Blackburn Br. 2). Three of the eight photographic negatives (P. Exs. 2-A to 2-H) do not now contain copyright notices (R.Tr. 25, 31, 34; P. Exs. 2-F, 2-G, 2-H). He testified to, but clearly did not

demonstrate, the condition of any of the negatives at the time they were provided to the County under the agreement. It is interesting to note that prior to the trial Blackburn stated that copyright notices were "affixed when made; at top and bottom of negatives in fourteen different places . . . ." (R. 66). Five of the negatives (P. Exs. 2-A through 2-E) do now contain the "big titles" in a total of fourteen different places, but the only evidence that the other three negatives ever contained any copyright notices or that any of them contained notices when provided to the County was Blackburn's testimony (R.Tr. 18-44).

Blackburn states that two negatives do not contain copyright notices (Blackburn Br. 11), whereas in fact three of the eight have no notices (P. Exs. 2-F, 2-G, 2-H; R.Tr. 25, 31, 34). In several places he cites pages of the record or transcript which do not support the proposition stated (e.g. Blackburn Br. 6 citing R.Tr. 69; Br. 14 citing R.Tr. 66; Br. 14 citing R.Tr. 36). At one point he accuses the County of misquoting the record (Blackburn Br. 22) but fails to mention where the alleged misquotation is to be found.

THE COPYRIGHTABILITY OF THE MAP AND THE OBLIGATION OF THE COUNTY TO AFFIX COPYRIGHT NOTICES WERE DECIDED BY THE TRIAL COURT AS ISSUES OF LAW.

In an apparent effort to divert attention from the fact that the trial court decided the issues of copyrightability and the obligation to affix copyright notices as

issues of law only, Blackburn contends that the County's brief makes "a strained and erroneous interpretation of the Court's ruling" which is "by no means a 'holding'" (Blackburn Br. 2-3), "an out of context, oblique gesture towards the trial judge" (Blackburn Br. 4) and an "attempted implication derogatory to the trial judge" (Blackburn Br. 10). A fair-minded reading of the County's brief indicates an effort to demonstrate that these issues were decided by the trial judge as issues of law upon the pleadings and stipulated facts at the commencement of the trial. They were not decided upon conflicting evidence or any testimony at the trial. All of the evidence on these issues which was before the trial judge is before this Court and is in the same form.

Blackburn conveniently ignores the fact that the question of whether the map contained sufficient original and creative work to be copyrightable under the laws of the United States was stipulated in the pretrial conference order to be an issue of law (R. 148, lines 18-20). The question whether the County was obligated under the contract or the law to affix copyright notices was also stipulated to be an issue of law (R. 147, line 11 - 148, line 7). None of the "issues of fact remaining to be litigated" in the pretrial conference order (R. 145, line 27 - 146, line 10) related to copyrightability of the map. The only "issue of fact remaining" related to whether the County was obligated under the agreement to affix copyright notices was whether copyright notices had

been discussed by Blackburn and any agent of the County (R. 145, line 31 - 146, line 3). The trial judge obviously decided that even if they had not been discussed, the County would be under an obligation to affix notices because the subject of the agreement was a map in which Blackburn claimed a copyright (R.Tr. 12-13, 14.)

The finding of fact (drafted by Blackburn's attorney) relating to copyrightability is merely a direct quotation of the admitted facts in the pretrial conference order (R. 162, lines 10-23; 144, line 28 - 145, line 9). The finding of fact relating to the agreement is also a direct quotation of the admitted facts in the pretrial conference order (R. 160, lines 20-26; 143, lines 9-15). The trial court also found that copyright notices were not discussed by Blackburn and any agent of the County (R. 163, lines 18-20). The County does not urge that any of these findings of fact should be reversed.

It is clear that the District Court in holding at the commencement of the trial that the map was copyrightable and that the County had an obligation under the contract and the law to affix copyright notices was deciding issues of law. The trial judge stated that he was disposing of law issues (R.Tr. 9, lines 11-14) and construing the written agreement (R.Tr. 12, line 23 - 13, line 6; 14, lines 15-17). He was not "merely voicing generalities with a view to orienting his mind to the trial of the case before him" (Blackburn Br. 3).

He was deciding issues of law as stipulated in the pretrial conference order (R. 147-149) and was narrowing the factual issue to be tried to whether Blackburn "waived his copyright" by giving the County photographic negatives without copyright notices (R.Tr. 13, lines 3-6; 15, line 25 - 16, line 4; 17, lines 6-8) and to the amount of damages (R.Tr. 17, lines 9-10). It certainly is not derogatory of a trial judge to state that he decided issues of law upon stipulated facts at the commencement of the trial.

The point, which Blackburn attempts to obscure, is that the District Court decided issues of law and that this Court therefore is not being asked to review findings of fact based upon conflicting evidence or the testimony of witnesses.

MERELY COPYING FROM SEVERAL SOURCES IS NOT SUFFICIENT ORIGINALITY AND CREATIVITY TO MAKE A MAP COPYRIGHTABLE AS A MATTER OF LAW.

In arguing that Blackburn's map does not contain sufficient original and creative work to be copyrightable under the law of the United States, the County does not disregard "with barefaced, unabashed abandon, its own lawyers' contract" (Blackburn Br. 4). It is the County's and Blackburn's contract, not "its own lawyer's contract," and it nowhere states that Blackburn's map contains sufficient original and creative work to be copyrightable. It nowhere states that Blackburn is the proprietor of a copyright or that the County recognizes as valid any claim which Blackburn may make to a

copyright.

The fact that the County paid Blackburn one thousand nine hundred dollars ($1,900) for a copy of the map and the right to reproduce and sell copies of the map certainly does not establish that the map contains sufficient original and creative work to be copyrightable under the law of the United States. Neither the contract nor any statement therein makes the map copyrightable or estops the County from asserting that it is not copyrightable. See Sawyer v. Crowell Pub. Co., 46 F.Supp. 471, 473 (S.D.N.Y. 1942). And the District Court correctly so concluded (R. 166, lines 18-19).

Blackburn's problem is that the only evidence of originality and creativity, the admitted facts (R. 144-145) and the identical findings of fact (R. 163, lines 10-23), shows nothing more than actual copying of various sources. The evidence does not show "something more than a 'mere trivial' variation, something recognizably 'his own'" (Blackburn Br. 5), or any "problems of tying the maps together, adjustment of scales, elimination of much material from the source" (Blackburn Br. 8) or any other original and creative work by Blackburn. In an apparent effort to create some evidence of originality, he quotes his answer to an interrogatory and cites the reporter's transcript of the trial as the source of the statement (Blackburn Br. 5-6). But even if this self-serving hearsay were evidence, it does not show any creative or original work on his part beyond mere actual copying from

various sources.

Thus, it is clear that the District Court's conclusion that the map was copyrightable was in fact based upon the erroneous premise that as a matter of law merely copying from three or more sources is sufficient original and creative work to make a map copyrightable.

A COVENANT TO AFFIX COPYRIGHT NOTICES WILL NOT BE IMPLIED AGAINST A PARTY TO AN AGREEMENT FOR THE SOLE PURPOSE OF MAKING THAT PARTY LIABLE IN DAMAGES TO THE OTHER PARTY FOR COPYRIGHT INFRINGEMENT.

Blackburn places great emphasis on the word "duplicate" in the agreement (Blackburn Br. 2, 9-10, 11, 15). The agreement (P. Ex. 1; R. 5-6; County Br. App. A) does talk of duplicate tracings of the map. But it says nothing about duplicate tracings of Blackburn's "big titles" or duplicate tracings of the negatives. The County obviously was interested in buying, and Blackburn in selling rights to the map, not to Blackburn's "big titles." An examination of the negatives (P. Exs. 2-A through 2-H) reveals that the "big titles" were not an integral or necessary part of the map contained on the negatives. The random and unusual placement of the "big titles" on the negatives indicates that they were placed there for Blackburn's own use (R.Tr. 19, 55-56) and were not a part of the map involved in the agreement. The omission of the "big titles" from the duplicate tracings of the map therefore does not make them anything other than duplicate tracings of the map.

Blackburn is apparently attempting to suggest that the inadvertent omission of a single dot or line of the map from a copy would prevent it from being a duplicate tracing of the map and would make it an infringement of the copyright. This rationale certainly requires a highly technical, strained and unreasonable interpretation of the words "duplicate tracing of the map." But even with Blackburn's interpretation of the phrase, the fact remains that the "big titles" were not a necessary or integral part of the map. The agreement says duplicate tracings of the map and that is precisely what the linen tracings (P. Ex. 2-A-1 through 2-H-8) are despite the absence of Blackburn's "big titles" with the little copyright notices.

The County certainly has not forgotten its earlier position that the copyright notices were not on the negatives or were blocked out before they were given to the County, as suggested by Blackburn (Blackburn Br. 11). We have not urged this defense on appeal for the simple reason that Blackburn testified that they were on the negatives when delivered to the County (R.Tr. 18-44) and the trial court so found (R. 163, lines 6-8). We are aware of the difficulties in overturning a finding of fact for lack of substantial evidence.

Blackburn quotes at length from National Comics Publications v. Fawcett Publications, 191 F.2d 594, 600 (2d Cir. 1951) and then completely ignores or misunderstands what he has quoted by stating that "if any 'forfeiture' occurred

. . . [it] must have been caused by the [County's] wrongfully failing to put the notice on the maps" (Blackburn Br. 14). The whole point of the National Comics case is that a licensee's wrongfully failing to put on notices (i.e., in breach of a promise exacted by the copyright proprietor to affix notices) does not cause a forfeiture of the copyright. Thus if the County wrongfully failed to put on notices, there was no forfeiture of the copyright. Whether publication without copyright notices by a licensee causes a forfeiture depends upon whether the proprietor exacted a promise to affix notices from the licensee and whether section 21 of the Copyright Act saves the copyright. Blackburn, of course, did not exact such a promise from the County, so the County did not wrongfully fail to put on notices. Whether the copyright was forfeited depends upon whether section 21 applies, but that need not be decided in this case. The issue here is whether the omission of notices from copies reproduced by the County was wrongful.

The agreement says nothing about copyright notices. They were never discussed (R. 163, lines 18-20) and there is no evidence that Mr. Rice or any other agent of the County saw the 1/8 inch by 7/8 inch word "copyright" which Blackburn said was on the negatives. The County had purchased copies of maps from Blackburn in prior years (R.Tr. 71, lines 5-12) which may have contained the "title" referred to in the agreement.

Although it may be safe to assume that the County's

"legal staff knew more about contracts than did Blackburn" (Blackburn Br. 15), it certainly is not safe to assume that the County District Attorney's staff knew more about copyrights, copyright notices and copyright licenses than did Blackburn. Blackburn has been in the map-making business for himself since 1927 (R.Tr. 45, lines 17-19) and has brought at least one other copyright infringement suit. Blackburn v. Southern California Gas Co., 14 F.Supp. 553 (S.D.Cal. 1936). One of the attorneys for Blackburn in that suit was named Porter C. Blackburn.

In Warner Bros. v. Columbia Broadcasting System, Inc., 216 F.2d 945 (9th Cir. 1954), Warner was claiming that it had acquired the exclusive right to use individual characters and their names together with the title of a book under a lengthy agreement in which it bought certain movie, radio and television rights. This court held that even if Warner had been assigned the complete copyright it would not have the exclusive right to the characters, because they were only the vehicle of the story and were not within the area of protection afforded by copyright. Here the County does not claim any exclusive rights or any right protected by copyright other than the right to reproduce and to sell copies of the map. The agreement is not a lengthy and detailed document drafted by a group of experts on copyright law and the publishing business. The County claims simply that this short and straightforward agreement does not require the County to affix

copyright notices.

Blackburn's implied negative covenant argument (Blackburn Br. 16-18) completely misses the point. The only reason for implying a covenant in this case is to make the County an infringer of copyright and liable for money damages. Implying a covenant to affix notices will not restore the value of the copyright because the County still has the right to reproduce and sell copies to the public at prices determined by the County. Such a covenant will not protect Blackburn from the competition of the County for sales of the map. It will not enable Blackburn to transfer any exclusive rights to anyone else. None of the cases cited by Blackburn implies a covenant to affix notices for the sole purpose of making a licensee liable in damages for copyright infringement.

If the law would imply a promise to affix notices where the agreement is silent merely because the subject of the agreement is copyrighted material, there was no need for Judge Hand to remand the National Comics case to determine whether the copyright proprietor had exacted a promise to affix notices from the licensee. Thus it is clear that the County is not, as a matter of law, under an obligation to affix copyright notices because the subject of the agreement was a map in which Blackburn claims a copyright.

SECTION 10 OF THE COPYRIGHT ACT DOES NOT IN ITSELF IMPOSE UPON THE COUNTY AN OBLIGATION TO AFFIX COPYRIGHT NOTICES.

Blackburn apparently argues (Blackburn Br. 19-20)

that even if he had expressly authorized the County to omit the copyright notices, the County would be liable for infringement because section 10 of the Copyright Act imposes a "mandatory duty" to affix notices. Section 10, he seems to say, makes such a contract illegal and void. Presumably under his rationale a copyright proprietor is barred from ever dedicating his work to the public because section 10 imposes a "mandatory duty" to affix notices. Blackburn's interpretation of section 10 is so patently erroneous that it needs no further answer.

The cases he cites do not hold or even suggest that section 10 of the Copyright Act in and of itself (or any other law) makes a licensee or assignee who prints without copyrigh notices liable in damages to the copyright proprietor for infringement of copyright. On the contrary, these cases hold that the burden is upon the proprietor of the copyright to ensure that proper copyright notices are affixed or to pay the price implied by the language of section 10, i.e. loss of the protection of the Copyright Act. See annot., 84 A.L.R.2d 462 (1960), "Abandonment of Statutory Copyright."

THE DISTRICT COURT FAILED TO DETERMINE THE AMOUNT OF DAMAGE CAUSED BY THE ABSENCE OF COPYRIGHT NOTICES FROM COPIES OF THE MAP DURING THE STATUTORY PERIOD.

Blackburn relies upon certain statements by Renie and himself (Blackburn Br. 21) as showing that the absence of notices during the statutory period was the only and entire

cause of the loss in value of the copyright. The hypothetical question put to Renie, however, included among other facts the passage of eight or nine years and the sale to the County in 1956 of the right to reproduce and sell copies to the public at prices to be determined by the County (R.Tr. 80). As Blackburn's attorney states, Renie testified that the value "was destroyed by the facts narrated and assumed by him from the hypothetical question put" (Blackburn Br. 27). Thus, he did not testify as to the amount of the loss in value caused by the absence of copyright notices from copies reproduced by the County during the period of the statute of limitations. Contrary to Renie's statement (R.Tr. 82), a copyright cannot be cast into the public domain by the omission or removal of copyright notices by some third party without the consent or authorization of the owner. See American Press Ass'n v. Daily Story Pub. Co., 120 Fed. 766 (7th Cir. 1902); Scarves by Vera, Inc., v. American Handbags, Inc., 188 F.Supp. 255 (S.D.N.Y. 1960). Whether Blackburn's copyright was cast into the public domain by his failure to exact a promise to affix notices depends upon whether section 21 of the Copyright Act can be applied to save it.

Blackburn also testified to the value of the copyright before the agreement with the County and to the value at the time of trial. He did not testify as to the amount of the loss in value caused by the absence of notices during the statutory period. On cross-examination he attempted to evade

the question as to what had been the effect of the agreement alone on the value of the copyright (R.Tr. 71-75).

The County does not urge that there is no evidence of any loss in the value of the copyright since 1954 or that loss in value as such is not an appropriate measure of damages when properly applied. The point is that Blackburn is entitled only to damages caused by the absence of notices during the statutory period (i.e. those "suffered due to the infringement"). 17 U.S.C. 101, 115.

Designating a conclusion of law as a finding of fact does not, of course, make it a finding of fact. To the extent that "Finding" XV (R. 164) is really a finding of fact, the County's position is that in making the finding the trial court misconceived the law and failed to apportion the loss in value between the various causes. There is no evidence as to the amount of the loss in value caused by the absence of notices during the statutory period. No consideration was given to the amount of the loss in value which was caused by the transfer of rights to the County in 1956, by depreciation in value over the years, by Blackburn's failure to keep his map current and up to date or by any other factors. The District Court erroneously concluded that the County was liable for the entire loss in value regardless of the various causes for such loss.

If this judgment stands, the County will be paying Blackburn's estimate of the full market value of the copyright

and yet will still be subject to future suits for infringement. Blackburn suggests (Blackburn Br. 28) that the changes made on the map over the years by the County are further infringements, and the trial judge suggested that Blackburn may recover from others who may copy his map. Thus the County faces the possibility of paying for "infringements" of this copyright even after it has paid Blackburn his estimate of the full market value of the entire copyright. Such a result is neither fair nor just.

CONCLUSION

For these reasons it is respectfully submitted the judgment below should be reversed with directions to enter judgment in favor of the County and costs and attorney's fees should be awarded to the County.

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County of Ventura
Courthouse
Ventura, California

November 1965.

C E R T I F I C A T I O N

I certify that, in connection with the preparation of this brief, I have examined Rules 18 and 19 of the United States Court of Appeals for the Ninth Circuit, and that, in my opinion, the foregoing brief is in full compliance with those rules.

Karl H. Bertelsen

KARL H. BERTELSEN
Deputy District Attorney
County of Ventura
State of California

DECLARATION OF SERVICE BY MAIL

I, SOPHIA DeLESDERNIER, declare:

I am a citizen of the United States, over 18 years of age, and not a party to the within cause; my business address is 501 Poli Street, Ventura, California; I served three copies of the attached reply brief for appellant on George R. Maury, attorney for appellee, by placing same in an envelope addressed as follows:

George R. Maury, Esq.
Suite 910
3440 Wilshire
Los Angeles, California.

Said envelope was then sealed and deposited in the United States mail at Ventura, California, the county in which I am employed, on November 5, 1965, with the postage thereon fully prepaid;

I declare under penalty of perjury that the foregoing is true and correct.

Executed at Ventura, California, on November 5, 1965.

Sophia DeLesdernier

SOPHIA DeLESDERNIER